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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,250

03/17/2004

Isidor Hazan

FA1165USNA

5975

23906

7590

08/20/2008

E I DU PONT DE NEMOURS AND COMPANY

LEGAL PATENT RECORDS CENTER

BARLEY MILL PLAZA 25/1122B

4417 LANCASTER PIKE

WILMINGTON, DE 19805

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

08/20/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-Legal.PRC@usa.dupont.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/803,250	<b>Applicant(s)</b> HAZAN ET AL.	
	<b>Examiner</b> Patrick D. Niland	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. The amendment of 5/6/08 has been entered. Claims 1-16 are pending.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 11/332064. Although the conflicting claims are not identical, they are not patentably distinct from each other because, although the claims differ somewhat in scope, they overlap to such an extent that the ordinary skilled artisan in practicing the copending claims would necessarily infringe the instant claims and vice versa. It would have at least been obvious to the ordinary skilled artisan to practice the instantly claimed inventions from the claims of the copending application due to this large scope overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The applicant has not pointed out how this rejection does not continue to apply. The rejection is therefore maintained.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-6, and 8-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5250605 Hazan et al..

Hazan discloses a composition which can be used as a primer surfacer containing the instantly claimed ingredients in the instantly claimed amounts at the abstract; column 2, lines 60-68; column 3, lines 1-68, particularly 4-26, 32-55, 48 of which 45-55 encompasses the amounts of the instantly claimed component (a) and the amounts of the instant claims 3 when coupled with pigment amounts, and claim 11, 49-55, which broadly encompasses component (a), 56-61 which falls within the scope of the instantly claimed molecular weight of component (a); column 4, lines 1-68, particularly 35-68 which falls within the scope of the claimed “silane functional compound with hydrolysable groups”; column 5, lines 1-68, particularly the formula of line 45 which falls within the scope of the urethane functional group of component (a) and the molecular weight polymer of this section also falls within the scope of the instant claim 6; column 6, lines

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1-68, particularly 35-44 which also falls within the scope of the instant claim 6; column 9, lines 1-68, particularly 8-68; column 10, lines 1-68; column 11, lines 1-68, particularly 52-68 and column 12, lines 1-68, particularly 39-50, which falls within the scope of the instantly claimed component (f) of claim 12; column 13, lines 1-68, particularly 30-56 which falls within the scope of the instantly claimed component d and its amount; column 14, lines 1-68; column 15, lines 1-68, particularly 32-43 which is its use as primer surfacer on plastic substrates, which encompasses the instantly claimed 13-16 since claim 16 recites no structure and thereby encompasses the substrates of the patentee which are useful in some capacity in an automotive body panel as they are assumed to be sheets, lines 44-55 of which carbon black and metallic flake pigments are the conductive pigments of the instant claim 5, and lines 65-68; column 16, lines 1-68, particularly 1-6; column 17, lines 1-68, particularly 1-10; and the remainder of the document. The silane functional binder of the patentee contains molecules of different molecular weights, monomer amounts, monomer distributions, etc. based on the well known polymer average molecular weights, average functionalities, etc. Therefore, the silane functional binder of the patentee contains a fraction that is different from the rest of the binder and which meets the instantly claimed component c and its amount including the difference now claimed based on at least the definition of average molecular weight. The applicant's arguments have been fully considered but are not persuasive for this reason. This rejection is therefore maintained.

7. Claims 1-6 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5250605 Hazan et al. in view of US Pat. No. 5413809 Hazan.

Hazan discloses a composition which can be used as a primer surfacer containing the instantly claimed ingredients in the instantly claimed amounts at the abstract; column 2, lines 60-

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68; column 3, lines 1-68, particularly 4-26, 32-55, 48 of which 45-55 encompasses the amounts of the instantly claimed component (a) and the amounts of the instant claims 3 when coupled with pigment amounts, and claim 11, 49-55, which broadly encompasses component (a), 56-61 which falls within the scope of the instantly claimed molecular weight of component (a); column 4, lines 1-68, particularly 35-68 which falls within the scope of the claimed “silane functional compound with hydrolysable groups”; column 5, lines 1-68, particularly the formula of line 45 which falls within the scope of the urethane functional group of component (a) and the molecular weight polymer of this section also falls within the scope of the instant claim 6; column 6, lines 1-68, particularly 35-44 which also falls within the scope of the instant claim 6; column 9, lines 1-68, particularly 8-68; column 10, lines 1-68; column 11, lines 1-68, particularly 52-68 and column 12, lines 1-68, particularly 39-50, which falls within the scope of the instantly claimed component (f) of claim 12; column 13, lines 1-68, particularly 30-56 which falls within the scope of the instantly claimed component d and its amount; column 14, lines 1-68; column 15, lines 1-68, particularly 32-43 which is its use as primer surfacer on plastic substrates, which encompasses the instantly claimed 13-16 since claim 16 recites no structure and thereby encompasses the substrates of the patentee which are useful in some capacity in an automotive body panel as they are assumed to be sheets, lines 44-55 of which carbon black and metallic flake pigments are the conductive pigments of the instant claim 5, and lines 65-68; column 16, lines 1-68, particularly 1-6; column 17, lines 1-68, particularly 1-10; and the remainder of the document. The silane functional binder of the patentee contains molecules of different molecular weights, monomer amounts, monomer distributions, etc. based on the well known polymer average molecular weights, average functionalities, etc. Therefore, the silane functional binder

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of the patentee contains a fraction that is different from the rest of the binder and which meets the instantly claimed component c and its amount including the difference now claimed based on at least the definition of average molecular weight.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed combinations of ingredients and amounts thereof in the compositions of the patentee because they are encompassed by the patentee and would have been expected to give the exceptional coating properties disclosed by the patentee. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amounts of pigment of claim 4 because the amount of pigment gives only predictable properties such as color, shade, hue etc. and is within the ability of the ordinary skilled artisan to adjust as evidenced by the patentee's lack of guidance in this regard.

Furthermore, it is expected that any choice of pigment amount would necessarily be within the instantly claimed very broad range to be useful. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed water scavenger of claim 10 because column 15, line 19 of the patentee discloses water scavengers including orthoformates, which are adjacent homologues of the instantly claimed orthoacetates, and Hazan (809) column 6, lines 43-46 show the instantly claimed orthoacetates to function as such water scavengers in similar compositions and they are therefore expected to function the same as their lower homologues in the compositions of Hazan et al..

The applicant's arguments have been fully considered but are not persuasive for this reason. This rejection is therefore maintained.

8. Claims 1-3, 6-9, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/55229 Uhlianuk et al..

Uhlianuk discloses the instantly claimed inventions at the abstract; page 1, lines 4-38; page 2, lines 1-38, particularly 22 and 35-38 which encompasses the instant claims 2 and 3 respectively; page 4, lines 1-38; page 5, lines 1-38, particularly 8-38 which encompasses the amounts of the instantly claimed component d; page 6, lines 1-38, particularly 26-38 which falls within the scope of the amount of the instantly claimed component a and b and the molecular weights are the instantly claimed molecular weights; page 7, lines 1-38; page 8, lines 1-38, particularly 28-38; page 9, lines 1-38, particularly 1-3 and 11-19, of which the disclosure of page 8, line 28 to page 9, line 10 discloses urethane functional monomer which meets the requirements of the instantly claimed component a noting that the formula of page 9 of the reference is mistaken in that the reaction product of NCO and OH is not accurately shown; page 10, lines 1-38, particularly 32-38 which is the instantly claimed component f; page 11, line 1- page 14, line 2; page 14, lines 3-38, particularly 34-38; page 16, lines 1-23 which falls within the scope of the instant claim 7 and the remainder of the document. It is not seen that the use of the reference is not a “primer surfacer” since it is used on the surface of the coated substrates therein. Furthermore, the compositions of the reference contain the instant claimed components and amounts and are therefore necessarily expected to be capable of use as “primer surfacer”.

The silane functional binder of the reference contains molecules of different molecular weights, monomer amounts, monomer distributions, etc. based on the well known polymer average molecular weights, average functionalities, etc. Therefore, the silane functional binder of the reference contains a fraction that is different from the rest of the binder and which meets



the instantly claimed component c and its amount including the difference now claimed based on at least the definition of average molecular weight. That it will function as coupling agent is not speculative since this function is inherent in the presence of the reactive SiOR groups which will necessarily bond, i.e. couple, with some moiety during their reaction.

The applicant's arguments have been fully considered but are not persuasive for the above stated reasons and the teachings of the cited prior art. This rejection is therefore maintained.

9. Claims 1-3 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/55229 Uhlianuk et al. in view of US Pat. No. 5413809 Hazan.

Uhlianuk discloses the instantly claimed inventions at the abstract; page 1, lines 4-38; page 2, lines 1-38, particularly 22 and 35-38 which encompasses the instant claims 2 and 3 respectively; page 4, lines 1-38; page 5, lines 1-38, particularly 8-38 which encompasses the amounts of the instantly claimed component d; page 6, lines 1-38, particularly 26-38 which falls within the scope of the amount of the instantly claimed component a and b and the molecular weights are the instantly claimed molecular weights; page 7, lines 1-38; page 8, lines 1-38, particularly 28-38; page 9, lines 1-38, particularly 1-3 and 11-19, of which the disclosure of page 8, line 28 to page 9, line 10 discloses urethane functional monomer which meets the requirements of the instantly claimed component a noting that the formula of page 9 of the reference is mistaken in that the reaction product of NCO and OH is not accurately shown; page 10, lines 1-38, particularly 32-38 which is the instantly claimed component f; page 11, line 1- page 14, line 2; page 14, lines 3-38, particularly 34-38; page 16, lines 1-23 which falls within the scope of the instant claim 7 and the remainder of the document. It is not seen that the use of the reference is not a "primer surfacer" since it is used on the surface of the coated substrates therein.

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Furthermore, the compositions of the reference contain the instant claimed components and amounts and are therefore necessarily expected to be capable of use as “primer surfacer”.

The silane functional binder of the reference contains molecules of different molecular weights, monomer amounts, monomer distributions, etc. based on the well known polymer average molecular weights, average functionalities, etc. Therefore, the silane functional binder of the reference contains a fraction that is different from the rest of the binder and which meets the instantly claimed component c and its amount including the difference now claimed based on at least the definition of average molecular weight. That it will function as coupling agent is not speculative since this function is inherent in the presence of the reactive SiOR groups which will necessarily bond, i.e. couple, with some moiety during their reaction.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed combinations of ingredients and amounts thereof in the compositions of the reference because they are encompassed by the reference disclosure and would have been expected to give the exceptional coating properties disclosed in the reference. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed water scavenger of claim 10 because Hazan (809) column 6, lines 43-48 show the instantly claimed orthoacetates to function as such water scavengers in similar compositions and they are therefore expected to function the same in the compositions of Uhlianuk and to give the increased pot life since there will be less water to consume reactive groups such as NCO and SiOR. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to coat plastic substrates with the coating compositions discussed above because Uhlianuk discloses coating automobiles (abstract

et seq.), automobiles are commonly made of plastic, the coating of Uhlianuk is one that is on top of the primer and on the surface and is thus a primer surfacer and the disclosure of the reference is such that no popping nor other defects are expected since these are contrary to the properties of page 1, lines 8-22 of Uhlianuk.

The applicant's arguments have been fully considered but are not persuasive for the above stated reasons and the teachings of the cited prior art. This rejection is therefore maintained.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/  
Primary Examiner  
Art Unit 1796